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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,149	12/31/2003	Zaven T. Saroyan	438P2043	7924

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EXAMINER

SAGER, MARK ALAN

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,149

Applicant(s)

SAROYAN, ZAVEN T.

Examiner

M. A. Sager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003 and 07 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/31/03, 4/7/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

1. The information disclosure statement filed 12/31/03 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. In particular, no copy of WO89/00066 was received.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the providing game official directions to move game ball to a location (clm 6), determining if game ball has crossed boundary, communicating out of boundary alert (clm 9), attaching and storing a time stamp to recorded position, providing game ball's position for selected time in response to query (clm 13), microprocessor comprising a clock, display/receiver comprising a clock (clm 22) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: attaching and storing a time stamp to the recorded position of game ball and providing ball's position for a selected time in response to query (clm 13).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for determining/signaling if a game ball has crossed a boundary of the playing field (such as goal line), does not reasonably provide enablement for an out of boundary condition such as sideline within conventional rules of football (presumably American football since it is only sport discussed) at least since under American football rules a football is out of bounds if a player steps onto or over a side line or if football touches boundary line or beyond while rolling on ground. However, an airborne football may be directly over or beyond a boundary sideline and not be out of bounds such as situation where an inbound player has control

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of ball that is above/beyond sideline (e.g. ball caught beyond side line while player is in-bounds).

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to enable the invention commensurate in scope with these claims.

Essentially, communicating an out of boundary alert as taught by specification provides a false alert when an in bound player has control of a ball extended above/beyond a boundary and there is no tracking/signaling taught regarding location/placement of player with respect to sideline such as whether both of a player's feet is inbound.

6. Claims 13-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to teach/suggest how to make/use the invention regarding attaching and storing a time stamp to the recorded position of said game ball and providing the game ball's position for a selected time in response to a query as particularly claimed.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 9-11 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how communicating an out of boundary alert considers location of player at least since a game ball may be determined to have crossed a boundary of playing field and yet not be out of bound within conventional rules of [American] football. It is unclear how a query for a selected time is done or what performs such function.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 12-18 and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Daver (5513854). Daver discloses a system and method for acquisition of data pertaining to objects in motion on a sport field (4:50-6:18, 7:39-8:52, 10:4-24, figs. 1-6) teaching claimed features/steps when Daver tracks all objects via signals transmitted from radio transmitters on all players and game ball (10:4-7) including transmitting first signal from game ball, receiving and analyzing first signal to determine position, communicating ball's position, displaying ball's location on a display, continuously recording ball's position, attaching and storing a time stamp, providing ball's position, graphically displaying ball's position, transmitter positioned in ball for transmitting signal, antenna for detecting signal, receiver receiving signal, a microprocessor for determining position, recording position, and means for communicating ball's position.

11. Claims 1-2, 9-12 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Orenstein (5976038). Orenstein discloses a apparatus for detecting a moving ball (1:24-2:37, 3:15-17, 29-40, 3:59-4:36) teaching claimed features/steps including transmitting first signal from game ball, receiving and analyzing first signal to determine position, communicating ball's position, determining if ball has passed a boundary of playing field, communicating audibly or visually an out of boundary alert, a receiver, a microprocessor, means for communicating visually or audibly.

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12. Claims 16 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Larson (5363297). Where carrying game ball is commensurate with handling of ball with respect to sport rules, Larson discloses automated tracking system for sports contests (5:6-16, 29-34, 6:16-43) teaching claimed features/steps including transmitting first signal from a player, receiving and analyzing first signal to determine position, communicating ball's position.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 4-8, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Daver or Orenstein each in view of either Brandon (4675816) or Utke (5346210). Daver or Orenstein each discloses claimed method or system (sic) but lacks selectively transmitting second signal, receiving second signal, recording ball's position in response to second signal and transmitting third signal to communicate ball's location, such as providing audible or visual directions to move the game ball to a location and selectively directing microprocessor to record

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ball's location for a point in time, selectively operable to send a control signal to record ball's position. Brandon (2:41-3:32) and Utke (supra) each disclose locator method/systems for re-locating a football for subsequent placement such as after an incomplete pass teaching selectively transmitting second signal, receiving second signal, recording ball's position in response to second signal and transmitting third signal to communicate ball's location, such as providing audible or visual directions to move the game ball to a location, selectively directing microprocessor to record ball's location for a point in time, selectively operable to send a control signal to record ball's position. Thus, it would have been obvious to an artisan at a time prior to the invention to add selectively transmitting second signal, receiving second signal, recording ball's position in response to second signal and transmitting third signal to communicate ball's location, such as providing audible or visual directions to move the game ball to a location and selectively directing microprocessor to record ball's location for a point in time, selectively operable to send a control signal to record ball's position, as claimed, as taught/suggested by either Brandon or Utke to either Daver or Orenstein to assist in reposition of football with improved accuracy in placement thereof.

16. Claims 9-11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daver in view of Orenstein (5976038). Daver discloses steps/features (sic) except determining if ball has passed a boundary of playing field, communicating audibly or visually an out of boundary alert, a second transmitter and a display means, as claimed. Orenstein (sic) discloses a apparatus for detecting a moving ball teaching determining if ball has passed a boundary of playing field, communicating audibly or visually an out of boundary alert, a second transmitter and a display means so as to improve accuracy of linear boundary calls by providing orientation of game ball.

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Thus, it would have been obvious to an artisan at a time prior to the invention to add determining if ball has passed a boundary of playing field, communicating audibly or visually an out of boundary alert, a second transmitter and a display means, as taught/suggested by Orenstein to Daver to improve accuracy of boundary calls/rulings.

17. Claims 1-15, 17-22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utke (5346210) in view of either Daver or Orenstein. Utke discloses an object locator system/method (abstract, 2:57-4:15, 5:14-6:65, 7:9-51, 7:57-8:52, 11:65-14:31, figs. 1-15) comprising all claimed features/steps including transmitting first signal, receiving and analyzing first signal to determine position, communicating ball's position, displaying ball's location on a display, selectively transmitting a second signal, receiving second signal, recording ball's position in response to second signal, transmitting a third signal, providing official directions audibly or visually to move the ball to a location by position recorded in response to second signal, continuously recording ball's position, attaching and storing a time stamp, providing ball's position, graphically displaying ball's position., a first transmitter, a first antenna, a first receiving a microprocessor having a clock, means for recording a position, , means for communicating ball's position, a receiver for receiving a signal to convey ball's location, a microprocessor for interpreting ball's location, and means for communicating ball's location visually or audibly but lacks except 'from the game ball' or 'in the game ball' or 'mounted therein' such that a transmitter is inside the game ball, as particularly claimed. However, Daver or Orenstein each disclose system/method teaching including a transmitter 'in the game ball' or 'mounted therein' so as to locate game ball on playing field based on signals transmitted 'from the game ball'. Therefore, it would have been obvious to an artisan at a time prior to the

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invention to add 'from the game ball' or 'in the game ball' or 'mounted therein' as taught or suggested by Daver or Orenstein to Utke to improve position determination of game ball and to eliminate necessity for game official to carry transmitter due to incorporation inside game ball (frees game official from carrying transmitter).

18. Claims 1-8, 12-15 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Utke (5346210). Utke discloses a object locator system (abstract, 2:57-4:15, 5:14-6:65, 7:9-51, 7:57-8:52, 11:65-14:31, figs. 1-15) teaching claimed features/steps including transmitting first signal from game ball, receiving and analyzing first signal to determine position, communicating ball's position, displaying ball's location on a display, selectively transmitting a second signal, receiving second signal, recording ball's position in response to second signal, transmitting a third signal, providing official directions audibly or visually to move the ball to a location by position recorded in response to second signal, continuously recording ball's position, attaching and storing a time stamp, providing ball's position, graphically displaying ball's position., a receiver for receiving a signal to convey ball's location, a microprocessor for interpreting ball's location, and means for communicating ball's location visually or audibly.

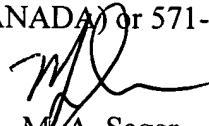
Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, John Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



M.A. Sager
Primary Examiner
Art Unit 3712

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